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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,853	06/08/2000	RAYMOND DE CAGNY	RSA254AUS	1690

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EXAMINER	
STORMER, RUSSELL D	

ART UNIT	PAPER NUMBER
3617	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No.	Applicant(s)	
	09/509,853	DE CAGNY ET AL.	
	Examiner	Art Unit	
	Russell D. Stormer	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "wherein said at least one surface of said is mounted..." is indefinite and not understood. It appears that some text has been omitted.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 7, 8, 9, 10, 11, 12, 14, 17, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Woolson.

Woolson discloses a tire balancing weight comprising a weight which is mounted to the tire. The weight comprises a plurality of linked members 10 which are joined and encased in a "patch" 8 to form a single weight. The member 8 is called a patch by

Woolson (probably because of how it is attached to the tire and because of the age of the reference), but the patch considered to be a case as broadly recited in the claims, and the member is vulcanized to the tire. To be vulcanized to the tire the case must be melted to some degree, and therefore the side of the case which is directly joined to the tire would comprise the means for mounting the case to the tire sidewall. Or, the surface of the case itself could be the means for mounting as this surface which contacts the tire holds the case to the tire. Though formed of linked members, the weight 10 is considered to be a single weight because the links, as joined together and enclosed in the case, make up a single balancing weight to be applied to the tire..

With respect to claim 5, the rubber material of the case of Woolson is a plastic material.

3. Claims 20 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Thissen et al (EPO 222391; newly cited).

The balancing weight 1 is encased in rings 30, 70 which form a case around the weight. The balancing device is mounted firmly to a surface of a side 28 of the tire as it is wedged in place.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3, 4, 6, 18, 19, 21, 24, 25, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson.

Woolson meets all of the limitations of claim 1 as set forth in paragraph 6 above but the material of the weight is not specifically set forth as being iron alloy or zinc and aluminum alloy. However, at lines 62-64 of page 1, Woolson describes the weights or links 10 as being made of any suitable material. Such suitable materials would include iron alloy (steel) and aluminum and zinc alloys since those of ordinary skill in the art would readily know that such material would perform well as balancing materials and would further be resistant to weather and would also be less poisonous than lead.

With respect to claim 6, the device would inherently include a convex surface during flexing of the tire.

With respect to claims 18 and 19 the color of the case is not patentable.

With respect to claim 21, to mount at least one device on each side of the tire would have been obvious to those of ordinary skill in the art in as needed to balance the tire.

With respect to claims 24 and 25, Woolson states that the balancing weight is vulcanized to "one side of the tire." Although not specified, it would have been obvious to mount the weight on the outboard surface of the tire to allow inspection, or on the inboard surface in order to hide the device. The device would balance the tire just the same, and those of ordinary skill in the art could readily determine which side of the tire the weight should be mounted to.

With respect to claims 31-34, it has long been known that wheel balancing weights may be marked with indicia showing the weight characteristic of the weight so that a mechanic attempting to balance a wheel and tire assembly can easily choose the

proper size weight to correct the imbalance. Further, the weight characteristics of the weight inherently determine where the weight must or will be mounted to the wheel or tire in order to correct the imbalance.

Claims 13, 15, 16, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson in view of Turoczi Jr.

To use an adhesive or glue to mount the device to the tire would have been obvious as taught by Turoczi Jr. as such is well-known and would be a simpler and less expensive alternative to the vulcanization used by Woolson. The use of adhesive tape falls within the teachings of Turoczi Jr. and therefore would further have been obvious to those of ordinary skill to reduce assembly time or facilitate attachment of the weight to the tire.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woolson in view of Flebbe (German 3632981; newly cited).

For the tire to include a circumferential groove for the reception of the balancing device would have been obvious as taught by Flebbe. Note the grooves in the tire, the spacer, and between the two as shown in figure 1 of Flebbe.

Response to Arguments

6. Applicant's arguments filed January 7, 2004 have been fully considered but they are not persuasive.

Because the balancing weight of Woolson is encased in the patch-like member 8, the weight is enclosed in a case. The patch 8 meets the broad claim language of a "case." The articulated links 10 are joined together and encased in the patch to form a *single weight*. It is not proper to suggest that the weight, when assembled, comprises more than one wheel balancing weight. Note lines 75-85 which state that other forms of weight may be used.

With respect to the newly added claims 31-34, note the previously cited Songer patent.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rds

February 18, 2004

RUSSELL D. STORMER
PRIMARY EXAMINER
2/18/04